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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,099	03/30/2004	Patrick E. Patterson	07650003C1	3091
23345	7590	09/08/2005	EXAMINER	
MCGUIREWOODS, LLP 1750 TYSONS BLVD SUITE 1800 MCLEAN, VA 22102			SALAD, ABDULLAHI ELMU	
		ART UNIT		PAPER NUMBER
		2157		

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/812,099	PATTERSON, PATRICK E.	
	Examiner	Art Unit	
	Salad E. Abdullahi	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 August 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 74-99 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 74-99 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 March 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/30/2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

Detailed Action

1. This application has been reviewed. Original claims 74-99 are pending. The rejection cited stated below.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 74-99 are rejected under the judicially created doctrine of double patenting over claims 1-78 of U. S. Patent No. 6,751,670. Although the conflicting claims are not identical, they are not patentably distinct from each other

because other than minor obvious variations the comparison made to independent claims 74, 75 and 90 of the instant application and independent claims 27, 32 and 66 of the patented claims reveal that independent claims 27, 32 and 66 of the patented claims are simply species of the broader claims 74, 75 and 90 of the instant application. Hence, claims 74, 75 and 90 of the instant application are generic to the species of the invention covered by claims 27, 32 and 66 of the patent. Thus, the broad generic invention is anticipated by the narrower of the species of the patented invention, thus without a terminal disclaimer, the species claims preclude issuance of the generic application. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 74-90 rejected under 35 U.S.C. 102(b) as being anticipated by Venkatraman et al U.S. Patent No. 6,014,688[hereinafter Venkatraman]. As per claim 74, Venkatraman discloses a method of regulating access to electronic content, the method comprising:

collecting notification information from a recipient of electronic content in response to an attempt to access the electronic content (see fig. 15 and col. 8, lines 1-42); transmitting the collected notification information to an address other than that of an immediate sender of the electronic content (see col. 8, lines 24-42); and selectively controlling access to the electronic content based on a result of the transmission of the notification information (see fig. 14 and col. 7, 47-67).

As per claim 75 Venkatraman discloses a method for acquiring information, comprising the steps of:

transmitting electronic data having computer executable instructions to a first computer col. 8, lines 1-42); and

receiving notification information in response to the execution of the computer executable instructions, wherein the notification information is collected by executing the executable instructions when triggered by an event at one or more successive computers other than the first computer and the notification information is received at a network address other than a network address transmitting the electronic data (see col. 8, lines 24-42).

As per claim 76 and 79, Venkatraman discloses the method of claim 75, further comprising the steps of:

communicating the electronic data to the one or more successive computers(see col. 8, lines 24-42);

transmitting the collected notification information to a network address other than the network address of the first computer(see col. 8, lines 24-42); and executing the computer executable instructions at the one or more successive computers when triggered by the event (see fig. 14 and col.7, 47-67).

As per claim 80, Venkatraman discloses the method of claim 75, wherein the electronic data comprises at least any one of an envelope and one or more files (see fig. 2).

As per claim 81, Venkatraman discloses the method of claim 75, wherein a portion of the electronic data includes electronic content other than the executable instructions (see col. 3, lines 5-65).

As per claim 82-83,Venkatraman discloses the method of claim 81, wherein the executable instructions denies access to the electronic content until the collected notification information has been transmitted the network address other than the network address transmitting the electronic data (see fig. 14 and col.7, 47-67).

As per claim 84, Venkatraman discloses the method of claim 81, wherein the electronic content includes at least any one of a text file, a graphics file, an audio file, a video file, an instruction file, and a program file (see col. 3, lines 5-65).

As per claim 85, Venkatraman discloses the method of claim 75, wherein the event is one of:

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- (i) an attempt by a user to access the electronic data(see fig. 14 and col.7, 47-67);
- (ii) an attempt by a user to save the electronic data;
- (iii) an attempt by a user to delete the electronic data; and
- (iv) an attempt by a user to list the electronic data.

As per claims 86-89, Venkatraman discloses the method of claim 75, wherein the notification information includes user information collected by querying a user for personal information (see figs. 14 and 15 and col. 7, line 47-67 and col. 8, line 1-24).

As per claim 90, Venkatraman discloses a method for assessing fees, comprising the steps of:

receiving electronic data having at least in part computer executable instructions from sending computer(see fig. 15 and col. 8, lines 1-42);
transmitting the electronic data and executable instructions to one or more successive computers(see col. 8, lines 24-42); and
executing the computer executable instructions at the one or more successive computers and upon receipt of an authorized user identifier at a network address other than a network address of the sending computer, granting access to at least a portion of the electronic data(see fig. 14 and col. 7, 47-67).

Note: The recitation “accessing fees” in the preamble has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the

intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

As per claims 93,94, 96, 97 and 98, Venkatraman discloses the method of claim 90, further comprising the step of obtaining user information when the computer executable instructions are executed (see fig. 15 and col. 8, lines 1-42).

As per claim 99 Venkatraman discloses the method of claim 90, further comprising encrypting at least a part of the electronic data (see col. 4, 61 to col. 5, line 2).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 77-78, 91, 92 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatraman as applied to claim 75 above, and further in view of Yoshida et al., U.S. Patent No. 6,075,862[hereinafter Yoshida].

As per claims 77-78, and 91, 92 and 95 Venkatraman discloses substantial features of the claimed invention as discussed above with respect to claim 75 and 90,

Venkatraman is silent regarding: computing usage charge

Yoshida discloses a software distribution system including the step of computing usage charge (see fig. 1 and col. 5, lines 14-27). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Yoshida into the system of Venkatraman such that content receivers can be charged according to their use of the content.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Salad E. Abdullahi whose telephone number is 571-272-4009. The examiner can normally be reached on 8:30 - 5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.
10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Abdullahi Salad

Primary examiner

8/29/2005